REMARKS

CLAIM REJECTIONS- 35 U.S.C. § 102

In the Office Action, Claims 1, 3-4, 6, 8-10, and 13, 15-16, 18, and 20-22 are rejected under 35 U.S.C. § 102(e) as being anticipated by Dasan, US Patent No. 5,761,662. Applicants respectfully disagree for the reasons provided below.

Because the Dasan patent is issued before the priority date of the instant application, the Applicants believe 35 U.S.C. § 102(a), rather than 102(e), is applicable, and will respond accordingly.

Legal Principles

Certain well established principles must be observed in assessing whether or not an invention is patentable under 35 U.S.C. 102(a). First, the claims of a patent, which define the invention, are "to be construed in light of the specification and both are to be read with a view to ascertaining the invention." United States v. Adams, 383 U.S. 39, 49, 148 USPQ 479, 482 (1966). During examination, the claims must be interpreted as broadly as their terms reasonably allow. This means that the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

The Dasan Patent

Dasan is directed to providing a personalized electronic newspaper. A user of Dasan's invention first defines a profile which identifies categories of information of interest to the user. Upon receiving a user request, the Dasan invention examines a database of information (e.g., news sources), automatically retrieves information of interest from the database, and presents the information of interest to the user. The Dasan invention further stores a file containing the user-defined profile.

Applying the Dasan Patent to Claims 1, 3-4, 6, 8-10, and 13, 15-16, 18, and 20-22

The Examiner's Action indicated that the Dasan patent discloses: providing a login construct to a client computer from a server computer (col. 6, lines 20-37); accepting at said server computer a login identifier from said client computer that corresponds to said user (col. 6, lines 20-37); using said login identifier to locate an unprocessed user profile associated with said login identifier in a user profile database when said unprocessed user profile exists (col. 3, lines 29-45); associating a new unprocessed user profile with said login identifier when said unprocessed user profile does not exist (col. 5, lines 53-64 and col. 6, lines 38-52); processing said unprocessed user profile to form a processed user profile, said processed user profile including a reference to each networked information monitor in said client/server computer system associated with said login identifier; wherein one said networked information monitor referenced in said user profile is a home networked information monitor (col. 8, lines 4-41); and delivering said home networked information monitor to said client computer in accordance with instructions in said processed user profile (col. 7, lines 42-60), said home networked information monitor capable of accessing each said networked information monitor capable of processing distributed computer readable media. (col. 8, lines 4-41).

Applicants respectfully traverse the rejections. It appears to the Applicants that the Examiner's Action has misread part of claim 1, which has been underlined above for the Examiner's convenience. In particular, claim 1 states:

> delivering said home networked information monitor to said client computer in accordance with instructions in said processed user profile, said home networked information monitor capable of accessing each said networked information monitor **associated with said login identifier, and each said networked information monitor** capable of processing distributable computer readable media. (Emphasis supplied).

It appears that the bolded text above has not been addressed by the Examiner's Action. Applicants respectfully submit that the aforementioned text, which is part of claim 1, is not taught by the Dasan patent.

The Dasan patent also fails to teach a networked information monitor or a home networked information monitor. As defined in the specification, a "networked information monitor" or "NIM" refers to "a fully configurable frame with one or more controls; the frame through which content is optionally presented." The fully configurable frame utilized in accordance with the invention stands in contrast to present web browsers, which are branded by the browser vendor and which have limited means by which to alter the controls associated with the browser. (Specification, page 7, lines 21-26). A home networked information monitor, or home NIM, coordinates the activities of all other NIMs that are accessed by a user. (Specification, page 7, lines 29-30). Claim 1 also includes the limitation that the home networked information monitor is capable of accessing each networked information monitor associated with the login identifier, and the limitation that each networked information monitor is capable of processing distributable computer media.

A visual manifestation of an example home NIM 164 is shown in Fig. 4 of the present application. Also shown are visual manifestations of two example NIMs 184 and 186. Nothing in the Dasan invention resembles a NIM or a home NIM.

Since the Dasan patent does not teach a NIM or a home NIM, the Dasan patent could not have taught or suggested a processed user-profile that includes "a reference to each networked information monitor in said client/server computer system associated with said login identifier." By the same token, the Dasan patent could not have taught or suggested a processed user-profile that includes a reference to a home networked information monitor.

Even if the Dasan patent teaches a NIM and a home NIM, it fails to teach processing an unprocessed profile to form a processed profile. The Examiner's Action indicated that col. 8, lines 4-41 of the Dasan patent taught the claim limitation. The Applicants respectfully traverse this interpretation. Dasan, in the cited paragraphs, discusses the processing of raw news sources and the displaying of profile name and a list of topics from the profile. However, there is nothing in Dasan that teaches or suggests processing an unprocessed profile to form a processed profile.

For the above reasons, the Applicants respectfully submit that claim 1 is not anticipated by the Dasan patent and is allowable. Claim 3-4, 6, 8-10, which depend on claim 1, are also allowable.

Claim 13 includes limitations similar to those in claim 1. In particular, claim 13 includes the limitation that the home networked information monitor is capable of accessing each networked information monitor associated with the login identifier, and the limitation that each networked information monitor is capable of processing distributable computer media, which are not taught or suggested by the Dasan patent. Claim 13 also includes a user profile processor module that includes instructions to process the unprocessed user profile to form a processed user profile. As discussed above, Dasan does not teach or suggest any of these limitations. Accordingly, claim 13 is not anticipated and is allowable. Claims 15-16, 18, and 20-22 are allowable as being dependent on claim 13.

With respect to claims 3 and 15, the Examiner's Action indicated that Dasan discloses detecting a designated keyboard entry sequence or mouse click corresponding to a selected network information monitor (col. 5, lines 8-21); and associating said selected networked information monitor with said processed user profile in response to said designated keyboard entry sequence or mouse click. (col. 5, lines 8-21).

The Applicants respectfully traverse. The cited paragraph of Dasan merely teaches that the Dasan invention can be practiced using a generic computer device having a keyboard and mouse. The Examiner's rejection, which is tantamount to saying that the limitations of claims 3 and 15 are taught by a generic computer device, is misplaced. A generic computer device, unless

programmed to perform the steps described in the claims, does not detect a designated keyboard entry sequence or mouse click corresponding to a selected network information monitor, and it does not associate the selected networked information monitor with the processed user profile in response to the designated keyboard entry sequence or mouse click. The Dasan patent never teaches or suggests programming a generic computer system to perform these claimed steps.

With respect to claims 4 and 16, the Examiner's Action indicated that Dasan discloses: obtaining a request from said client for a specified networked information monitor (col. 3, lines 29-45), routing said request to an address corresponding to said specified networked information monitor (col. 3, lines 29-45 and col. 4, lines 53-64); and transmitting said specified networked information monitor to said client (col. 3, lines 29-45).

The Applicants respectfully traverse. In the cited paragraphs, the Dasan patent merely teaches a generic client/server environment using a generic computer device having CPU, ROMs, and RAMs on which the Dasan invention can be practiced. The Examiner's rejection, which is tantamount to saying that the limitations of claims 4 and 16 are taught by a generic client/server system, is misplaced. The Applicants herein did not invention the client/server computing model. A generic server computer, unless programmed to perform the steps described in the claims, does not obtain a request from a client for a specified networked information monitor, it does not route a request to an address corresponding to a specified networked information monitor; and it does not transmit a specified networked information monitor to a client. The Dasan patent never teaches or suggests programming a generic computer system or server system to perform these claimed steps.

With respect to claims 6 and 18, the Examiner's Action indicated that Dasan discloses: designating a plurality of networked information monitors (col. 6, lines 10-19); collecting a reference of each said designated networked information monitor into a pack (col. 5, line 65 – col. 6, line 37); assigning a name to said pack (col. 5, line 65 – col. 6, line 37); and storing said pack in said processed user profile (col. 5, line 65 – col. 6, line 37 and Fig. 7).

The Applicants respectfully traverse. In col. 6, lines 10-19, the Dasan patent merely teaches a newspaper generator that uses a plurality of raw news sources to generate personalized

newspapers. The cited paragraph does not teach "designating a plurality of networked information monitors."

It appears that the Examiner's Action has interpreted the term "networked information monitor" to include raw news feeds, such as Reuters, Associated Press, etc. However, this interpretation is unwarranted. The specification of the present application clearly specifies that a "networked information monitor" or "NIM" refers to "a fully configurable frame with one or more controls; the frame through which content is optionally presented." The fully configurable frame utilized in accordance with the invention stands in contrast to present web browsers, which are branded by the browser vendor and which have limited means by which to alter the controls associated with the browser. (Specification, page 7, lines 21-26). A home networked information monitor, or home NIM, coordinates the activities of all other NIMs that are accessed by a user. (Specification, page 7, lines 29-30).

During examination, the claims must be interpreted as broadly as their terms *reasonably* allow. This means that the words of the claim must be given their plain meaning *unless applicant has provided a clear definition in the specification.* In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). In this case, interpreting the term "networked information monitor" to mean a raw news source is unreasonable. The Applicants respectfully submit that a raw news feed or news source, such as Reuters, Associated Press, etc., has *never* been called a "networked information monitor," and that a person of ordinary skill in the art would not have called a raw news feed or a raw news source a "networked information monitor." The Applicants' undersigned representative has performed a Google search (www.google.com) on the Internet for the term "networked information monitor," but did not find any reference that uses the term to refer to a raw news source. The Examiner is invited to perform the same Google search and other searches on the Internet using different search engines. Furthermore, the term "networked information monitor" is clearly defined in the specification and therefore at the very least the term should be given a meaning consistent with the defined meaning. A raw news source or a new feed is clearly not consistent with "a fully configurable frame with one or more controls; the frame through which content is optionally presented."

Other paragraphs of the Dasan patent also fail to teach this and other limitations of claims 6-18. In col. 5, line 65 – col. 6 line 10, the Dasan patent teaches a newspaper generator that creates a profile and store the profile in local files, which may be accessed at a later time and recalled from session to session. In col. 6, lines 11-18, the Dasan patent teaches a newspaper generator that uses a plurality of raw news sources. In col. 6, lines 20-37, the Dasan patent describes the operations of the newspaper generator. In particular, in col. 6, lines 20-37, the Dasan patent describes a process where the user enters the name of his profile and optionally his password. Fig. 7 of Dasan depicts a process of adding a topic of interest to his profile. The Applicants respectfully submit that these teachings are irrelevant to the limitations of claim 6 and 18 and that the Examiner's Action failed to show a *prima facie* case that these claim limitations are anticipated by the Dasan patent.

With respect to claims 8 and 20, the Examiner's Action indicated that Dasan discloses: identifying a designated networked information monitor (col. 6, lines 38-52 and col. 8, lines 4-21); collecting a description of said designated networked information monitor into a container (col. 6, lines 38-52 and col. 8, lines 4-21); assigning a name to said container (col. 6, lines 38-52 and col. 8, lines 4-21); storing said container in a sharelink database; wherein, upon storage of said container in said sharelink database, a unique identifier is assigned to said container, said unique identifier capable of locating said container in said client/server computer system (col. 6, lines 38-52 and col. 8, lines 4-21); and distributing said unique identifier to another user of said client/server computer system.

The Applicants respectfully traverse. In col. 6, lines 38-52, the Dasan patent discusses a process where a user can edit his profile. If a profile exists, the raw news sources are scanned according to the keywords/topics/subject stored in the profile, and the matching information is gathered. If a profile does not exist, the user is given an option to create and edit the profile. In col. 8, lines 4-21, the Dasan patent discusses a text-searching process performed on raw news sources to identify the articles containing search terms. The located articles are converted into individual files and stored on the server. The titles of the articles are used as anchors in the HTML page, which reference the individual files.

The Applicants respectfully submit that these teachings are irrelevant to the limitations of claim 8 and 20 and that the Examiner's Action failed to show a *prima facie* case that these claim limitations are anticipated by the Dasan patent. For instance, claim 8 includes a step of "distributing said unique identifier to another user of said client/server computer system." There is nothing in the cited paragraphs that teaches or suggests distributing anything to another user of the system.

With respect to claim 9 and 21, the Examiner's Action indicated that the Dasan patent in col. 6, lines 38-52 and col. 8, lines 4-21 teaches the limitations of these claims. The Applicants respectfully traverse and submit that these teachings are irrelevant to the limitations of claim 9 and 21 and that the Examiner's Action failed to show a *prima facie* case that these claim limitations are anticipated by the Dasan patent. For instance, claim 9 includes a step of "distributing said unique identifier to another user of said client/server computer system." There is nothing in the cited paragraphs that teaches or suggests a step of distributing anything to another user of the system.

With respect to claims 10 and 22, the Examiner's Action indicated that the Dasan patent in col. 6, lines 38-52 and col. 8, lines 4-21 teaches the limitations of these claims. The Applicants respectfully traverse. Claims 10 and 22 are directed to movement of the visual manifestation of a NIM in relation to the visual manifestation of another NIM. Visual manifestations of several example NIMs are shown in Fig. 4. According to claims 10 and 22, when a visual manifestation of a first NIM is moving to towards a visual manifestation of another NIM, and the visual manifestation of the first NIM is close enough to the visual manifestation of the second NIM, then the movement is accelerated. But if the visual manifestation of the first NIM is not close enough to the visual manifestation of the second NIM, the movement rate is not accelerated.

The Applicants respectfully submit that these limitations of claim 10 and 22 are clearly not anticipated by Dasan and that the Examiner's Action failed to show a *prima facie* case of anticipation.

CLAIM REJECTIONS - 35 U.S.C. § 103(a)

In the Office Action, claims 2, 5, 7, 14, 17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dasan and further in view of Gifford et al., US Patent No. 6,549,612. Applicants respectfully traverse and request the Examiner to consider the following remarks.

Legal Principles

Certain well established principles must be observed in assessing whether or not an invention is patentable under 35 U.S.C. 103(a). First, the claims of a patent, which define the invention, are "to be construed in light of the specification and both are to be read with a view to ascertaining the invention." United States v. Adams, 383 U.S. 39, 49, 148 USPQ 479, 482 (1966). The "differences between the prior art and the claims at issue are to be ascertained." Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). Moreover, it is elementary that the claimed invention must be considered as a whole in deciding obviousness. Litton Industrial Products, Inc. v. Solid State Systems Corp., 755 F. 2d 158, 164, 255 USPQ 34, 38 (Fed. Cir. 1985). The prior art as a whole must be considered, and those portions of the prior art arguing against or teaching away from the claimed invention must be considered. Bausch & Lomb, Inc v. Barnes-Hind/Hydrocurve, Inc., 796 F. 2d 443, 448, 230 USPQ 416, 420 (Fed. Cir. 1986), In re Hedges, et al., 783 F. 2d 1038, 1041, 228 USPQ 685, 687 (Fed. Cir. 1986). Moreover, "[t]he mere fact that the prior art could be ... modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." (Emphasis supplied.) In re Gordon, 733 F. 2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) which cites with approval Carl Schneck, A. G. v. Nortron, Corp., 713 F. 2d 782, 787, 218 USPQ 698, 792 (Fed. Cir. 1983) and In re Sernaker, 702 F. 2d 989, 995-96, 217 USPQ 1, 6-7 (Fed. Cir. 1983), both citing In re Imperato, 486 F. 2d 585, 587, 179 USPQ 730, 732 (CCPA 1973). In accord, In re Laskowski, 871 F. 2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989).

Establishing a *prima facie* case of obviousness requires that the prior art give reason or motivation to make the claimed invention. In re Dillon, 919 F. 2d 688, 692-93, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990) (en banc), cert denied, 500 U.S. 904 (1991). (Emphasis supplied.)

Second, there must be a reasonable expectation of success. Third, the references when combined must teach or suggest all the claim limitations. MPEP 2141. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (1991).

The mere fact that a reference can be modified does not render the resultant modification obvious unless the prior art also suggest the desirability of the modification. MPEP 2143 (emphasis supplied).

Finally, it is impermissible to first ascertain factually what the inventor did and then view the prior art in such a manner as to select from the random facts of that art only those which may be modified and then utilized to reconstruct the invention from such prior art. Panduit Corp. v. Dennison Manufacturing Co., 774 F. 2d 1082, 1092, 227 USPQ 337, 343 (Fed. Cir. 1985). (Emphasis supplied.)

Applying these principles to the invention as embodied in the present claims and to the Dasan and Gifford references, the Applicants respectfully submit that a proper reading of the references fails to disclose or suggest the invention embodied in the present claims.

The Gifford Patent

Gifford discloses a method and system for providing unified messages services to a subscriber. The subscriber utilizes an active interface embedded in an e-mail notification to control delivery of a non-literal, single media or multimedia message to the subscriber. Such a non-literal message includes, but is not limited to, any of a hyperlink-based message, a voicemail message, a facsimile, and a video clip. The active interface provides access to communications-related services as well, including access to stock/options trading and bill payment.

Applying the Dasan and Gifford References to Claims 2, 5, 7, 14, 17, and 19

In order to establish a *prima facie* case of obviousness, controlling authority mandates that all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

As described above in the preceding section, the Dasan patent fails to teach or suggest limitations of the independent claims 1 and 13. Specifically, the Dasan patent fails to teach or suggest a "networked information monitor," which was referred to as "a fully configurable frame with one or more controls; the frame through which content is optionally presented" in the specification. The Applicants respectfully submit the Gifford patent also fails to teach or suggest anything that can be reasonably interpreted to be a "networked information monitor." Therefore, the rejections under 35 U.S.C. § 103(a) cannot stand because the Dasan and Gifford patents do not teach all limitations of the rejected claims.

Even if the Dasan patent or the Gifford patent suggests a "networked information monitor," the combination still fails to teach or suggest limitations of the rejected claims. With respect to claims 5, 7, 17 and 19, the Examiner's Action indicated that the Gifford patent teaches:

> said processed user profile is periodically stored as said unprocessed user profile in said user profile database during a period of time in which said home networked information monitor is running (Gifford, col. 13, lines 9-19).

In the cited paragraph, the Gifford patent discusses a process for terminating a "login" session of the Gifford invention. More specifically, as discussed in Gifford, the "login" session expires when a Netscape Cookie expires. Furthermore, a user can click on a "logout" URL link, which artificially sets the expiration date of the Netscape Cookie to a date and time in the past, thereby causing the Cookie and thus the "login" session to expire. It is the Applicants' opinion that the cited paragraph is irrelevant to the claim limitation. At the very least, the cited paragraph did not mention or suggest periodically storing a processed user profile as an unprocessed user profile. Accordingly, the Applicants respectfully submit that the Examiner's Action fails to establish a *prima facie* case of obviousness for claims 5, 7, 17 and 19.

CLAIM REJECTIONS - 35 U.S.C. § 103(a)

In the Office Action, claims 11-12 and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dasan and further in view of Dolan et al., US Patent No. 5,801,702. Applicants respectfully traverse and request the Examiner to consider the following remarks.

The Dolan Patent

Dolan discloses a user interface through which a user can access information. The user interface presents information in a hierarchical graph, which provides an intuitive and convenient navigation tool for both experienced and novice users. The Dolan patent also discusses a view window that includes horizontal and vertical scroll bars, which are well known.

Applying the Dasan and Dolan References to claims 11-12 and 23-24

Claims 11 and 23 are directed to movement and presentation of the visual manifestation of a collection of NIMs. Example visual manifestations of a collection of NIMs are shown in Fig. 4. According to claims 11 and 23, when visual manifestations corresponding to a collection of NIMs are pushed against a boundary, the visual manifestations are pushed into an alignment that is based on the shape of the boundary. Figs. 10A-10C of the instant application illustrate how a set of visual manifestations corresponding to a collection of NIMs is aligned against a boundary when a user selects the visual manifestations and pushes them against the boundary. According to claims 11 and 23, the alignment is maintained when a visual manifestation is moved. That means the set of visual manifestations move together when one of the visual manifestation is moved.

As the Examiner's Action points out, the Dolan patent teaches scrolls bars. But scroll bars are not the same as the claim limitations. As is well known in the art, moving the scroll bar button will cause different portions of the content within a Window to be displayed. The alignment of the content within the Window, however, is not affected by the scroll bar. The Examiner's Action confirms this understanding by pointing out that the scroll bars are used by the user to select a portion of the substantive information in view window. The Dolan patent and

the Dasan patent, at least in the cited paragraphs, do not teach or suggest using the scroll bar to align previously unaligned objects that will move together as a group after the objects are aligned.

Thus, claims 11 and 23, these claims are allowable. Claims 12 and 24, which are dependent on claims 11 and 23, are also allowable as a result.

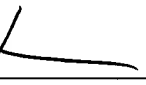
As an alternative ground for allowance, claims 11 and 23 are dependent on claims 1 and 13, which are allowable.

CONCLUSION

In light of the above, Applicants respectfully submit that the pending claims are allowable. Applicants believe a telephone interview would help clarify issues of the present application and advance prosecution of this case, and respectfully request the Examiner to contact the undersigned attorney to set up a mutually convenient time for a telephone interview.

Respectfully submitted,

Date December 19, 2003



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